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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,314	08/07/2001	Angelica M.T. Mastwyk	29800	1027
29800	7590	08/10/2006	EXAMINER SUBRAMANIAN, NARAYANSWAMY	
A.S.A.P. HEMELVUUR 2 DE MEERN, 3454SV NETHERLANDS			ART UNIT 3628	PAPER NUMBER

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,314	Applicant(s) MASTWYK ET AL.	
	Examiner Narayanswamy Subramanian	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Original claim 1 is pending in the application and has been examined. The rejections are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For instance the claim recites the limitation of “The ability to give an unambiguous answer (yes or no) to the question whether a security transaction on the stock exchange is, at that moment, compliant with legal rules and company regulations before the transaction is executed”, however there is no enabling disclosure described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear from the language of the claim as to whether the claimed invention pertains to “a method” or “an apparatus”. Clarification is required.

Claim 1 is also rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: It is not clear how the three features cited in the claim are related to each other. Appropriate clarification/correction is required.

For the purpose of art rejection, the examiner interprets claim 1 to be a method claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 1 is rejected under 35 U.S.C. § 101 because it fails to provide a useful, concrete and tangible result. It is not clear what useful, concrete and tangible result is derived from the system design that is claimed in claim 1. If it is a method claim, there is no positive recitation of any of the steps of the claim and hence it is not clear as to what is the outcome of the method. If it is an apparatus claim it is not clear what the components of the apparatus are and how these components are related to provide a useful, concrete and tangible result.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burakoff et al (US Patent 6,122,635) in view of Zothner (US Patent 6,775,658 B1).

Claim 1, Burakoff discloses the ability to give an unambiguous answer (yes or no) to the question whether a security transaction on the stock exchange is, at that moment, compliant with legal rules and company regulations before the transaction is executed (See Burakoff Column 1 line 15 – Column 4 line 19); the ability to do so based on actual daily updated information about the job content and job activities of the staff involved and the work-flows within the organization (See Burakoff Column 1 line 15 – Column 4 line 19); the ability to combine the data from the Personal Insiders Profile-form with the data mentioned above and also synchronize those with real-time inline news, stock prices and other publicly known market news in order to put the trading request in a proper context, which might be used in later proceedings (See Burakoff Column 1 line 15 – Column 4 line 19); the ability to do so based on actual daily updated information about the job content and job activities of the staff involved and the work-flows within the organization (See Burakoff Column 1 line 15 – Column 4 line 19).

Burakoff does explicitly teach the step of a periodical email or other alert message will ask the insiders whether they have any new knowledge that they want to have added to their Personal Insider Profile.

Zothner teaches the step of sending a periodical email or other alert message to concerned parties according to certain rules (See Zothner abstract and Column 2 line 61 – Column 3 line 29).

Both Burakoff and Zothner are concerned with alerting the users when certain conditions are met. It would have been obvious to one of ordinary skill in the art to modify Burakoff to include the teaching of Zothner. The combination would have helped the user be notified about alert conditions in a timely manner.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Breen Jr. et al. (US Patent 6,598,027 B1) (July 22, 2003) Systems, Methods and Computer Program Products for Conducting Regulation-Compliant Commercial Transactions of regulated Goods via a Computer Network

(b) Buddle et al (US Patent 6,912,502 B1) (June 28, 2005) System and Method for Compliance Management

(c) Makipaa (US Patent 5,489,213) (February 6, 1996) Method and System for Employee Business Conduct Guidelines Education

(d) Harris et al (US Patent 5,517,406) (May 14, 1996) Method and Apparatus for data verification and position reporting in an automated Trade Transactions Processing System

(e) Ehnebuske et al (US Patent 6,016,477) (January 18, 2000) Method and Apparatus for Identifying Applicable Business Rules

(f) Barrett et al (US Patent 6,029,144) (February 22, 2000) Compliance-to-Policy Detection Method and System

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

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(571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sub Sough can be reached at (571) 272-6799. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian
August 6, 2006